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Paper No. 9

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In re Application of :
Truett :
Application No. 10/003,590 : ON PETITION
Filed: October 31, 2001 :
Attorney Docket No. 1024 :
For: HYBRID LIMIT SWITCH :

This is a decision on the petition under 37 CFR 1.137(a), and in the alternative, under 37 CFR 1.137(b), to revive the above-identified application. Both petitions were filed in the same paper on April 26, 2004.

The petition under 37 CFR 1.137(a) is **dismissed**.

The petition under 37 CFR 1.137(b) is **granted**.

The above-identified application became abandoned for failure to timely respond to the Restriction Requirement set in the October 23, 2002 Office action. The Office action set an extendable one month period for reply. On January 21, 2003 (certificate of mailing date January 13, 2003), applicant filed an amendment. This amendment was untimely because applicant did not file a request for a two month extension of time and submit the required fee. On April 9, 2003, petitioner alleges that a telephone conversation between himself and a USPTO employee took place, during which the USPTO employee told petitioner to submit a two month extension of time fee immediately in order to avoid abandonment. On April 10, 2003, petitioner mailed a $205.00 check with a request for a two month extension of time. The Office's position is that the application became abandoned on January 24, 2003. A Notice of Abandonment was mailed on April 16, 2004.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was

unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks item (3).

Regarding (3) above, petitioner has not shown to the satisfaction of the Commissioner that the entire delay from the due date of the reply to the filing of a grantable petition was unavoidable.

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 USC § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word unavoidable ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a).

The Office mailed a Restriction Requirement on October 23, 2002. The Office action set an extendable one month period for reply. Petitioner filed an election on January 13, 2003. Unfortunately, petitioner did not submit a request for a two month extension of time and required fee at that time. Therefore, the January 13, 2003 election was untimely.

Petitioner filed a request for a two month extension of time and required fee on April 10, 2003. However, the extension fee due on April 10, 2003 was **$985.00**, which was the then-current small entity fee for a **5 month** extension of time.

As explained in MPEP 710.02(e), where a reply is filed after the set period for reply has expired

and no petition or fee accompanies it, the reply will not be accepted as timely filed until the petition and the appropriate fee are submitted. In this case, for the election to have been considered timely filed, a request for a 5 month extension of time and a check for $985.00 were required. In essence, petitioner bought an extension of time only to January 23, 2004, when an extension of time to April 23, 2004 was required.

A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

Regarding petitioner's allegation that a USPTO employee told him that the untimely election would be acceptable with only a request for a two month extension of time and required fee, petitioner is reminded that official communication with the Office must be carried out in writing. 37 CFR 1.2. Oral advice from Office employees is not binding. See In re Sivertz, 227 USPQ 255,256 (Comm'r Pat. 1985). The USPTO employee's alleged statements cannot eviscerate USPTO regulations.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

Petitioner has submitted a reply in the form of an election, an acceptable statement of the unintentional nature of the delay in responding to the October 23, 2002 Office action, and the $665.00 petition fee.

The petition under 37 CFR 1.137(b) is **GRANTED**.

After the mailing of this decision, the application will be forwarded to the examiner of record in Technology Center GAU 2832 for consideration of the election filed January 21, 2003 (certificate of mailing date January13, 2003).

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 308-6712.

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